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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/689,136	10/12/2000	John F. Engelhardt	875.032US1	7933
21186	7590	11/03/2004	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			SULLIVAN, DANIEL M	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/689,136

Applicant(s)

ENGELHARDT ET AL.

Examiner

Daniel M Sullivan

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-12, 29-36, 83, 84, 86, 87.

Claim(s) withdrawn from consideration: 37-82.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Daniel M Sullivan
PRIMARY EXAMINER

Continuation of 2. NOTE: The previously rejected claims were directed to a method comprising identifying an agent that enhances adeno-associated virus transduction after viral binding to the cell membrane and before second strand synthesis. Newly added claims 88 and 89, directed to a method comprising identifying an agent which enhances adeno-associated virus transport to the nucleus, are not limited to identifying an agent that acts after viral binding to the cell membrane. Because, an agent that enhances adeno-associated virus binding to the plasma membrane would reasonably be encompassed within the scope of an agent that enhances adeno-associated virus transport the nucleus (i.e., binding to the plasma membrane is the first step in transport of an adeno-associated virus from the extracellular medium to the nucleus), the scope of claims 88 and 89 is broader than the previously examined claims. Therefore, the claims require additional search and examination..

Continuation of 5. does NOT place the application in condition for allowance because: Had the amendment been entered, the amendments to claims 1 and 87 would have overcome the outstanding rejections under 35 U.S.C. §112, first and second paragraphs, and 35 U.S.C. §102.

RESPONSE TO REMARKS

Interview:

On page 11, Applicant states, "Applicant's representatives pointed out that a § 102 'inherency' rejection over Ferrari et al. J. Virol. 70:3234 (1996) was not appropriate and the Examiner agreed." As clearly indicated on the Interview Summary form, agreement with respect to the claims was not reached in the interview. The Examiner's comments during the interview merely indicated which lines of reasoning, when presented on the record in fully developed form, would be more likely to be considered persuasive.

35 U.S.C. §112 rejections:

Applicant's remarks are predicated on entry of the amendment and, as the amendment has not been entered, are moot.

35 U.S.C. §102 rejection:

On page 12 of the remarks, Applicant urges that the claims are patentably distinct from the method of Ferrari et al. because, "although Ferrari et al. purportedly tested that plasmid for its effect on AAV uncoating (page 3231), Ferrari et al. measured levels of nuclease resistant virion DNA (Figure 5), not necessarily viral uncoating." By this, Applicant appears to be asserting that Ferrari et al. is not enabling for a method of measuring viral uncoating. Ferrari et al. clearly considers the presence of nuclease resistant virion DNA to be an indicator of encapsidated viral genome and a relative decrease in nuclease resistant DNA to be an indicator of an increased rate of viral uncoating. If Applicant's position is that nuclease resistant virion DNA is not a valid indicator of encapsidated DNA and cannot be used to measure viral uncoating, a fully reasoned argument and evidence to support this contention should be set forth on the record.